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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,024	01/23/2004	John K. Solheim	KMC-594	7949

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,024

Applicant(s)

SOLHEIM ET AL.

Examiner.

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

This Office action is responsive to communication received 01/23/2004 – application papers filed.

Claims 1-17 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Grace ('939). As to claim 1, club head (1) includes body (2), face insert (7) and cavity insert (6). Figure 2 shows how face insert (7) includes a rear surface having a second cavity within which the cavity insert (6) is fitted. The main body (2) includes a cavity (4) within which the face insert (7) coupled with the cavity insert (6) is introduced. As to claim 3, the face insert may be formed of a polymer material (col. 2, lines 23-38). As to claim 15, Grace clearly discloses that a club head body is provided with a front face that includes a first cavity (4), and further shows the steps of providing a face insert (7), providing a cavity insert (6), installing the cavity insert (6) with a second cavity (9), as

shown in Figure 2, and mounting the face insert within the first cavity (4) in the club head.

Claims 2, 4-6, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grace ('939) in view of Boord. Grace shows every feature claimed with the exception of specifically stating that the face insert is adhesively secured to the first cavity and with the exception of stating the specific claimed materials for the club head body and the cavity insert. Boord shows it to be old in the art to provide a stainless steel putter body (col. 3, lines 37-38) to which a face insert comprising, in part, elements (29), (77) and (32) are attached within a frontal recess. In view of Boord, it would have been obvious to modify the Grace device by fabricating the main body (2) from any commonly available metal material, the motivation being to take advantage of the availability of these materials and the ease with which club heads may be made from these materials using known processes. For example, stainless steel is commonly used to make putter heads, as this material is easy to cast in a mold. Boord also shows that adhesive is used to secure at least a portion of the insert within the cavity in the front part of the club head body (col. 3, lines 54-56). Thus, the use of adhesive or other appropriate bonding material to matingly secure the face insert within the first cavity of the Grace device, as defined above, would have been obvious. In addition, Boord would appear to guide the skilled artisan to select materials for the insert(s) commensurate with the specific effect that the face portion of the putter head is supposed to produce. Here, Boord selects a mix of high density materials and transparent plastics in order to create an insert that includes a soft brass plate in

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combination with an advertising insert (77) and a transparent epoxy covering (68).

Thus, for example, if the skilled artisan were to have been interested in an insert that displays vibration-damping characteristics, the skilled artisan would have known which polymer materials to select based upon the natural properties of shock-absorbing materials available in the art. It is clear from a reading of Boord and the above reasoning that the selection of a suitable material for either the face or cavity inserts claimed by the applicant would have been obvious to the skilled artisan, simply to take advantage of the properties of select materials. Where materials are chosen based upon their natural properties, such selection has been established as being obvious to the skilled artisan. See In re Hopkins 145 USPQ 140.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grace ('939) in view of Heene. The patent to Grace lacks a continuous lip and further lacks any mentioning of the first cavity and face insert dimensions. Heene shows it to be old in the art to provide ribs (100) to help position the face insert within the front portion of the club head (col. 4, lines 10-12). While it may be argued that the protrusions (100) are not formed as a continuous lip, such is merely deemed to involve an obvious difference in design. Clearly, a continuous lip would also serve to help position the insert within the front cavity. Moreover, it is not seen how a continuous lip would serve any unobvious purpose or solves any unknown problem that the discontinuous design of Heene does not already address. In view of the patent to Heene and the above reasoning, it would have been obvious to modify the Grace device by providing the face insert with a lip, albeit continuous, in order to properly align

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and fit the face insert with the first cavity (4) in the main club head body. As for the claimed cavity dimensions and lip extensions, these values are not deemed critical. Clearly, the skilled artisan would have found it obvious to appropriately size the cavity opening, face insert thickness, and lip dimensions based upon the overall size of the club head and the type of materials used for the various parts of the head.

Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grace ('939) in view of Boord and Heene. The patent to Grace shows every feature claimed with the exception of specifically stating that the face insert is adhesively secured to the first cavity and with the exception of stating the specific claimed materials for the club head body and the cavity insert. The patent to Grace also lacks a continuous lip and further lacks any mentioning of the first cavity and face insert dimensions. Specific to claims 10-12, Boord shows it to be old in the art to provide a stainless steel putter body (col. 3, lines 37-38) to which a face insert comprising, in part, elements (29), (77) and (32) are attached within a frontal recess. In view of Boord, it would have been obvious to modify the Grace device by fabricating the main body (2) from any commonly available metal material, the motivation being to take advantage of the availability of these materials and the ease with which club heads may be made from these materials using known processes. For example, stainless steel is commonly used to make putter heads, as this material is easy to cast in a mold. Boord also shows that adhesive is used to secure at least a portion of the insert within the cavity in the front part of the club head body (col. 3, lines 54-56). Thus, the use of adhesive or other appropriate bonding material to matingly secure the face insert within the first cavity of

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the Grace device, as defined above, would have been obvious. In addition, Boord would appear to guide the skilled artisan to select materials for the insert(s) commensurate with the specific effect that the face portion of the putter head is supposed to produce. Here, Boord selects a mix of high density materials and transparent plastics in order to create an insert that includes a soft brass plate in combination with an advertising insert (77) and a transparent epoxy covering (68). Thus, for example, if the skilled artisan were to have been interested in an insert that displays vibration-damping characteristics, the skilled artisan would have known which polymer materials to select based upon the natural properties of shock-absorbing materials available in the art. It is clear from a reading of Boord and the above reasoning that the selection of a suitable material for either the face or cavity inserts claimed by the applicant would have been obvious to the skilled artisan, simply to take advantage of the properties of select materials. Where materials are chosen based upon their natural properties, such selection has been established as being obvious to the skilled artisan. See In re Hopkins 145 USPQ 140. Specific to claims 10, 13 and 14, Heene shows it to be old in the art to provide ribs (100) to help position the face insert within the front portion of the club head (col. 4, lines 10-12). While it may be argued that the protrusions (100) are not formed as a continuous lip, such is merely deemed to involve an obvious difference in design. Clearly, a continuous lip would also serve to help position the insert within the front cavity. Moreover, it is not seen how a continuous lip would serve any unobvious purpose or solves any unknown problem that the discontinuous design of Heene does not already address. In view of the patent to

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Heene and the above reasoning, it would have been obvious to modify the Grace device by providing the face insert with a lip, albeit continuous, in order to properly align and fit the face insert with the first cavity (4) in the main club head body. As for the claimed cavity dimensions and lip extensions, these values are not deemed critical. Clearly, the skilled artisan would have found it obvious to appropriately size the cavity opening, face insert thickness, and lip dimensions based upon the overall size of the club head and the type of materials used for the various parts of the head.

Claim 13 objected to because of the following informalities: Claim 13 improperly depends from claim 13. Appropriate correction is required.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hsu, Christensen and Rohrer show putter head inserts, of interest. See col. 2, line 38 through col. 3, line 60 in Grace ('229). Note Figure 8 in Dewanjee. See insert (13) in Lezatte.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
January 8, 2005